

## **REMARKS/ARGUMENTS**

Applicant has received and carefully reviewed the Office Action mailed October 27, 2009. Claims 11-20 are pending and have been rejected. Applicant respectfully traverses all adverse assertions and rejections presented in the Office Action. Favorable consideration of the following remarks is respectfully requested.

### ***Claim Rejections – 35 USC § 103***

Claims 11-17, 19, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frid et al. (U.S. Patent No. 6,159,228) in view of Gunderson (U.S. Patent No. 5,776,142). After careful review, Applicant must respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03).

In the Office Action, Frid et al. is acknowledged as lacking certain limitations found in the pending claims. Specifically, Frid et al. do not disclose the inner and outer shaft portions having a second position wherein the distal end of the inner shaft engages the distal end of the outer shaft. Frid et al. also do not disclose the distal end of the inner shaft is positioned within the lumen of the outer shaft in the first position. Gunderson is advanced as providing these missing elements. Applicant respectfully disagrees, and further submits that Frid et al. appear to have been mischaracterized.

On page 2 of the Office Action, Frid et al. are asserted to disclose an outer shaft 7, an inner shaft 5, and an exterior tube 12. Frid et al. disclose these features as follows: reference numeral 7 is expressly disclosed as “a connector or Luer”, reference numeral 5 is expressly disclosed as a “proximal end”, and reference numeral 12 is expressly disclosed as a “radio-detectable zone”. It is unclear to Applicant how a “connector or Luer” can be considered to be the claimed outer shaft, how a “proximal end” of a device can be considered as the claimed inner shaft, or how a “radio-detectable zone” can be considered to be the claimed exterior tube.

The Office Action asserts that “Gunderson teaches a stent delivery device similar to the device of Frid having an outer shaft 30 and an inner shaft 28, the inner shaft is slidable between a first delivery position and a second deployed position...[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Frid to include the proximal shaft configuration of Gunderson to increase control over the relative movement of the distal ends of the shafts by engaging the proximal end of the shafts”. Applicant is unclear as to the relevance of this assertion. The claims do not recite engaging the proximal ends of the shafts. The claims require the distal end of the inner shaft to engage the distal end of the outer shaft in the second position. Additionally, Gunderson does not appear to teach an inner shaft 28 is “slidable”, as asserted in the Office Action. Gunderson appears to teach a handle 20 includes a screw portion 26 including threads 28 which are received in threaded opening 32 of second handle 30. Thus, handle 20 and handle 30 are not “slidable” with respect to each other. The threaded engagement between the two elements appears to require that the handles are “screwed” together, which therefore appears to define rotational engagement, and not a sliding engagement. For at least these reasons, the combination of Frid et al. and Gunderson does not appear to teach each and every element required by claims 11, 19, and 20, and the proposed combination appears to be improper.

On page 3 of the Office Action, Frid et al. is further acknowledged to lack a stepped exterior tube comprising a wide diameter end and a sheath, the wide diameter end being rigidly coupled to the distal end of the outer shaft. Instead, Frid et al. are acknowledged as teaching an exterior tube is received within the distal end of the outer shaft member. The Office Action states that the arrangement of Frid et al. and the arrangement of the pending claims are both “known methods of attaching two components...[t]herefore, it would have been an obvious matter of design choice” to provide the arrangement claimed in the device of Frid et al. Applicant respectfully disagrees.

As acknowledged in the Office Action, Frid et al. do not teach or suggest each and every claim limitation, as is required to establish a *prima facie* rejection. In fact, the Office Action appears to identify more than one difference between the teachings of Frid et al. and the pending claims. The Office Action asserts that the arrangement of the

pending claims is “known”, but has provided no reference(s) to corroborate such an assertion. Since the cited combination fails to teach the limitation of a stepped exterior tube, and no reference has been provided which appears to disclose this limitation, the rejection under 35 U.S.C. §103 appears to lack the necessary evidence to support a *prima facie* rejection. Therefore, the rejection of independent claims 11, 19, and 20, as presented in the Office Action, is believed to be improper.

Even further still, since Frid et al. are acknowledged as not disclosing a stepped exterior tube comprising a wide diameter end and a sheath, Frid et al. cannot disclose the treatment element mounting region is covered by the distal end of the (nonexistent) sheath in the first position and uncovered by the sheath in the second position, as asserted on page 2 of the Office Action.

For at least the reasons discussed above, Frid et al. and Gunderson (alone or in combination) do not appear to teach each and every element of independent claims 11, 19, and 20, as is required to establish a *prima facie* rejection. Therefore, claims 11, 19 and 20 are believed to be patentable over the cited references. Since claims 12-17 depend from independent claim 11 and add additional elements thereto, these claims are also believed to be patentable over the cited references. Withdrawal of the rejection is respectfully requested.

Claims 10 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frid et al. in view of Gunderson, in view of DiCaprio et al. (U.S. Patent No. 6,176,843). Applicant respectfully directs the Examiner’s attention to the fact that claim 10 was canceled in an earlier communication and is not a currently pending claim. Appropriate correction is respectfully requested in any future office action(s). After careful review, Applicant must respectfully traverse the rejection of claim 18.

Independent claim 11 appears to be patentable over Frid et al. and Gunderson for at least the reasons discussed above. DiCaprio et al. do not appear to remedy the shortcomings of Frid et al. and Gunderson with respect to claim 11. Therefore, claim 11 is believed to be patentable over the cited combination. Since claim 18 depends therefrom and adds additional elements thereto, Applicant believes claim 18 is also

patentable over the cited references. Withdrawal of the rejection is respectfully requested.

***Conclusion***

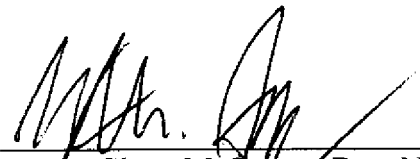
In view of the foregoing, all pending claims are believed to be in condition for allowance. Further examination, reconsideration, and withdrawal of the rejections are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By her Attorney,

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